

DETAILED ACTION

1. Amendment filed on 12/31/2009 is acknowledged. Claims 34, 38-40 remain pending and claim 41 has been withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 39-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure of the applicators being unattached to the sealed package so that the applicator is readily removable.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 34, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 5,470,323) in view of Hack et al. (US 5,874,066) and Discko (US 6,049,934).
6. Smith shows a pre-dosed system 10 comprising a sealed package having a first chamber and a second chamber, a first applicator 20 having a first applicator portion pre-dosed with a first dry inactive material placed within the first chamber and a second applicator 22 having a second applicator portion pre-dosed with a second dry inactive material placed within the second chamber (column 3 line 61). With respect to the applicator being unattached to the sealed package, the applicator is unattached to cover sheet 12. Patentable weight is not given to the intended use of the system; however, the system is capable of having the material combined on dental tissue and have desensitizing effect.
7. Hack teaches dental desensitizer material used with applicators. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the material of Hack with the applicator portions of Smith in order to apply material to hypersensitive teeth and tissue.
8. The modified system of Smith and Hack discloses a system that shows the limitations as described above; however, they do not show the applicator end portion placed on a tapered end of an elongated handle having a reduced diameter neck and placing a flock material on the applicator portions. Discko teaches an embodiment of a dental system comprising an applicator end portion placed on a tapered end of an elongated handle having a reduced diameter neck and placing a non-absorbent flock

material on the applicator portion (flock ball 326; Discko's flock material is plastic and non-absorbant). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system to have the handle and flock material of Discko in order to provide increased convenience to the user in applying materials and a surface suitable for applying powders.

Response to Arguments

9. Applicant's arguments with respect to claims 34, 38-41 have been considered but are moot in view of the new ground(s) of rejection.

10. With respect to the previously restricted claim 41, claim 41 is referring specifically to a multi-chamber package which is different than the originally filed claims directed to a pre-dosed dental desensitizing system. Since applicant has received an action on the merits for the originally presented invention, this invention was constructively elected by original presentation for prosecution on the merits.

11. With respect to there being support for "...so as to be unattached to said sealed package, whereby said second applicator is readily removable from said sealed package...", Examiner does not see any support for it being unattached in the lines provided by Applicant. A part may be attached and still be removable. The disclosure is therefore not explicit enough and this limitation is still considered new matter.

12. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The deficiencies of Smith et al. and Hack et al. are present in their modification with Discko.

13. Applicant argues with respect to the structural integrity of the packaging, but none of these arguments are directed to the claim language.

14. Applicant argues that it is with impermissible hindsight that the prior art is combined. However, sufficient rationale has been provided in the above rejections. Particularly, the primary reference of Smith shows a dried agent coating an applicator (col. 3, lines 59-62). Examiner does not see how it would be impermissible to simply substitute a different, known applicator in the art or substitute a similarly known agent.

15. Applicant argues that Smith's applicators are relatively large and could not be used in the small confines of a patient's mouth, however nothing in the disclosure of Smith prohibits the applicator being capable of use within a patient's mouth.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew M. Nelson whose telephone number is (571) 270-5898. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MMN/

/Cris L. Rodriguez/
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